

Remarks

The Office Action mailed August 21, 2007 has been carefully reviewed. The foregoing amendment has been made in consequence thereof.

Applicants believe that no extension of term is required and that no additional fee for claims is required. If any additional fee is required for an extension of term or claims, the Commissioner is hereby authorized to charge Deposit Account No. 01-2384.

Claims 32-56 are now pending in this application, of which claims 42-44 and 50 have been amended. It is respectfully submitted that the pending claims define allowable subject matter.

Applicants will now turn to the rejections made under 35 U.S.C. § 102 and § 103.

A. Hartman

The rejection of claims 32-36, 38 and 39 under 35 U.S.C. § 102(b) as being anticipated by Hartman (U.S. Patent No. 3,369,660) is respectfully traversed.

Hartman discloses a display package fabricated from cardboard and plastic. The Office Action in paragraph 4 states that plastic and cardboard are considered non-rigid as they can be bent and deformed. This position is respectfully submitted to be improper because it is inconsistent with the present specification.

It is well established that in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation *consistent with the specification*. In re Sneed, 218 USPQ 385 (Fed. Cir. 1983). The position taken in the Office Action with respect to cardboard and plastic materials appears to ignore all context of the invention disclosed and being claimed. Applicants note, for example, in paragraph [0004] of the specification that conventional cardboard packaging is relatively rigid, and in paragraph [0025] Applicants describe in relation to their invention that the base 12 and the cover 14 are "fabricated from

nylon, canvas, cloth, or other suitable material to form a non-rigid or soft sided, yet structurally sufficient package relative to comparatively rigid cardboard and paper materials conventionally used in non-food product packaging, and especially in comparison to known plastic and metallic materials conventionally used in hard-shell case construction.” Thus, the cardboard and plastic materials disclosed by Hartman and relied upon by the Examiner in the present rejection are expressly distinguished in the specification as being a non-rigid material within the scope of the claim. The present rejection, that is expressly inconsistent with the present specification, is therefore respectfully submitted to reply upon an improper claim construction. When properly interpreted in a manner consistent with the specification, the Hartman reference does not anticipate claim 32 or dependent claims 33-36, 38 and 39 stemming from independent claim 32. The plastic and cardboard materials disclosed by Hartman are not “non-rigid” materials within the scope of claim 32.

Applicants therefore request that the § 102(b) rejection of claims 32-36, 38 and 39 be reconsidered and withdrawn.

B. Johnson et al.

The rejection of claims 32-34, 36-48 and 56 under 35 U.S.C. § 102(e) as being anticipated by Johnson et al. (U.S. Patent No. 2005/0045521) is respectfully traversed.

Johnson et al. disclose a soft-sided cooler having a spinning pointer (28) for entertainment purposes. The pointer (28) is cited in the Office Action as a product being offered for sale. Applicants respectfully disagree, and submit that the position taken in the Office Action is not consistent with the ordinary meaning and understanding of a “product being offered for sale” in the marketplace, nor is the position taken anywhere supported by the teaching of the Johnson et al. reference. The position taken is akin to claiming that a wristwatch for sale is actually an offer for sale of the hands on the face of the watch. While there might be some literal truth to such a view, it does not accurately reflect the realities of the marketplace, and those in the packaging field would not share the examiner’s view set as set forth in the Office Action.

Johnson et al. describe a product (the cooler) having a particular feature (the pointer) that may be desirable to certain purchasers, but the feature (the pointer) is not itself a product being offered for sale in the ordinary sense of the phrase. The pointer is bundled with the cooler for purchase, but it would be a stretch, to say the least, that the pointer of the cooler constitutes a product being offered for sale. The product disclosed by Johnson et al. is clearly a cooler, and whatever accessories it may contain do not change its essential character as a cooler product. Surely a merchant disclosing the Johnson et al. cooler would not advertise it or promote it as a “pointer” nor would any bona fide consumer view it as a “pointer for sale.” From the merchant’s perspective and the consumer’s perspective, the assembly disclosed by Johnson et al. is a cooler product and nothing else.

A myriad of bundled products present analogous issues as the Johnson et al. cooler product with a pointer, all of which point to a similar conclusion. For instance, many toy and entertainment products are sold nowadays that include batteries, but the purchase of such items are not ordinarily considered to be battery purchases. Batteries are indeed offered for sale and are purchasable as a stand alone product, but one buying a toy including a battery is buying a toy product and not a battery. Merchandisers don’t advertise, promote, or offer “batteries” for sale when they are bundled with another product such as a toy, but rather advertise, promote or offer the product (the toy in this example) for sale.

More specific examples involving “pointers” may illustrate the issue further. One who buys a compass having a pointer would not ordinarily consider himself to be purchasing a pointer, nor would merchants ordinarily consider offering “pointers” for sale when merchandising compass items. As another example, many board games includes pointers as part of the game, but a purchaser of a board game does not ordinarily think of this transaction as a purchase of a pointer, nor do merchandisers present such board games to the public as pointers for sale. This is no less the case with the cooler of Johnson having the pointer for entertainment purposes. The pointer is not fairly characterized as a product to be sold, but the cooler having the pointer is. Merchandisers certainly would not advertise or promote the Johnson et al. cooler as a pointer for sale, and consumers would not recognize the cooler as an offer for sale of the pointer.

Applicants also disagree with the position taken in the Office Action that the references to footwear in certain claims are only intended use that does not differentiate the claimed apparatus. Claim 42 has been amended for clarity and now recites, among other things, a plurality of soft side walls extending from said support surface and defining a cavity accommodating a single pair of footwear being offered for sale above said support surface. This is not intended use, but is a positive recitation of a relationship between the soft side walls and a specific product, namely footwear. Independent claim 50 recites footwear and the soft side walls in combination and does not recite intended use.

For the reasons set forth above, Applicants request that the § 102(b) rejection of claims 32-34, 36-48 and 56 be reconsidered and withdrawn.

C. Leung

The rejection of claims 42, 46-48, and 50 under 35 U.S.C. § 102(e) as being anticipated by Leung (U.S. Patent No. 6,726,019) is respectfully traversed.

Independent claims 42 and 50 have each been amended for clarity to recite footwear to be worn by a person. Leung disclose a doll display that includes a doll and a doll ensemble 32 including shoes 34. This is clearly distinguishable from the inventions now being claimed. Applicants traverse the notion, for the same reasons set forth above, that the footwear 34 of the Leung doll cited in the Office Action is fairly characterized as being offered for sale within the ordinary meaning and context of the phrase. The shoes 34 are bundled with the doll, and the doll is the product that would be offered for sale. The shoes 34 are merely an accessory to the doll and are secondary to its purchase.

Lueng discloses vinyl walls which the Office Action cites as being considered soft as it can easily be deformed, but the disclosure of Leung is not consistent with this view. Rather, Leung describes a “sturdy rugged construction” that lends itself to use by young children, and that provides ready access to the contents of the of the case “without loss of case sturdiness.” See Col. 1. lines 55-64. Soft side walls would not provide such sturdiness, and would tend to collapse on the on the doll and ensemble of Leung due to the relative elongation of the container

in its vertical direction. This would almost certainly be undesirable, and would make the container very difficult for young children to use. In context, Leung does not describe soft side walls in relation to the doll display as recited in each of independent claims 42 and 50.

Soft sided walls with stiffeners, as Applicants disclose in the specification, would not be desirable for the Leung container either, because they could pose potential danger to young children. In any event, stiffeners are not disclosed by Leung, presumably because the side walls already possess sufficient rigidity and sturdiness as to render them unnecessary.

Leung does not anticipate independent claims 42 or 50, and by extension does not anticipate their dependent claims either.

For the reasons set forth above, Applicants request that the § 102(b) rejection of claims 42, 46-48, and 50 be reconsidered and withdrawn.

D. Davis

The rejection of claims 42-49 under 35 U.S.C. § 102(b) as being anticipated by Davis (U.S. Patent No. 4,334,601) is respectfully traversed.

Applicants traverse the notion that claim 42 recites intended use for the reasons set forth above. As Applicants have now argued repeatedly, Davis nowhere discloses footwear being offered for sale in connection with the utility bag described. Indeed, the Office Action concedes in paragraph 9 that Davis fails to describe a specific content of the bag. Claim 42 is clearly not anticipated by Davis, and by extension none of claims 43-49 are anticipated either.

For the reasons set forth above, Applicants request that the § 102(b) rejection of claims 42-49 be reconsidered and withdrawn.

E. Davis in view of Official Notice

The rejection of claims 32-41 and 50-56 under 35 U.S.C. § 103(a) as being unpatentable over Davis (U.S. Patent No. 4,334,601) in view of Official Notice is respectfully traversed.

Applicants traverse the Official Notice. Official Notice may be used for “facts...capable of such instant and unquestionable demonstration as to defy dispute.” See In re Ahlert, 424 F.2d 1088, 165 USPQ 418, 420 (CCPA 1970). Applicants submit that the Official Notice provided in the Office Action does not include facts that are capable of instant and unquestionable demonstration as to defy dispute. More specifically, Applicants submit that the assertion that it is old and conventional to include equipment and shoes including cleats in a sports equipment bag at a point of purchase is not a fact that is capable of instant and unquestionable demonstration as to defy dispute.

Applicants have been provided no evidence whatsoever in the last several Office Actions to support the position taken, and Applicants have now repeatedly disputed such assertions. The Office apparently has not succeeded in finding any reference that actually teaches or discloses product and footwear being offered for sale in connection with the packages presently claimed in the pending independent and dependent claims. Applicants are likewise not aware of any package to sell products, footwear or otherwise, that meet all the recitations currently claimed so as to anticipate them. Applicants are also unaware of any reference that would render the presently claimed invention obvious. Absent some evidence to support its position, the Office cannot rest upon Official Notice wherein the ultimate conclusion is questionable and unsupported by any evidence on the record. Nothing in the Davis disclosure reasonably suggests the invention claimed, and the Office may not fill gaps in the teaching of Davis with alleged Official Notice in such circumstances. Accordingly, Applicants submit that the Official Notice taken in the Office Action is procedurally improper.

Applicants also remind the Office that the U.S. Supreme Court in KSR has stated that some articulated reasoning having a rational underpinning to support the conclusion of obviousness is required for a proper obviousness analysis. The present rejection does not meet this standard as it reflects nothing more than a conclusion that the present claims are obvious. The Office Action states that it would have been obvious to provide the package of Davis with sporting equipment such as shoes in order to sell the equipment and the bag at the same time. Insofar as Applicants are aware, however, sports equipment (especially shoes) and sports bags

have long been sold separately, and offering them as separate items for sale has not been an impediment to selling them at the same time if a customer desires both. Having no inherent problem with separately selling such items, there is no common sense reason to rationally explain the Office's position that Davis renders the present claims obvious.

It is further submitted that selling sports equipment inside the "utility bag" may not be that desirable to merchants selling, or consumers buying, sporting equipment. Many purchasers of cleats, for example, will already have a utility bag and would not desire to purchase another one, as will many purchasers of utility bags have no need to purchase cleats. This perhaps explains why, at least as far as Applicants are aware, that cleats are sold separately from sports bags. Davis discloses a multi-compartment utility bag for carrying beverages and sports items, but consistent with Applicants' understanding does not disclose that either the beverages or sports items are sold inside the bag. Insofar as Applicants are aware, general purpose utility bags are simply not sold with product in them. It is generally up to the consumer/user of the utility bag to pack it with any item(s) desired, that may or may not be newly purchased.

Applicants are not claiming a general purpose utility bag, but a specific product and package combination. There is simply no evidence on the record *why* it would have been obvious to sell product/footwear in the packages claimed. The present claims are believed to recite a unique combination of package and product/footwear that no evidence of record, including Davis, fairly disclose or suggest. Absent some evidence that presents a prima facie case of unpatentability of the claims, which up until has not been properly supplied by the Office, Applicants respectfully request that the rejections be withdrawn and the claims allowed.

For the reasons set forth above, Applicants request that the § 103(a) rejection of claims 32-41 and 50-56 be reconsidered and withdrawn.

F. Conclusion

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in dark ink, appearing to read "Bruce T. Atkins", is written over a horizontal line.

Bruce T. Atkins
Registration No. 43,476
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070